IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Xiao Zhang	§	Filed: October 10, 2003
	§	Group Art Unit: 3688
Serial No.: 10/684,125	§	Examiner: James W. Myhre
Confirmation No.: 2745	§	

For: CROSS-SELLING IN STANDALONE SALES SYSTEMS

MAIL STOP AMENDMENT
Commissioner for Patents
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February 5, 2009 /Joseph Jong/
Date Joseph Jong

REQUEST TO REOPEN PROSECUTION IN RESPONSE TO EXAMINER'S ANSWER DATED DECEMBER 5, 2008

In response to the Examiner's Answer dated December 5, 2008, having a shortened statutory period for response set to expire on February 5, 2009, Applicant requests reopening prosecution of this application to address the new grounds of rejection presented by the Examiner. Please enter this response and reconsider the claims pending in the application for reasons discussed below.

While no fees are believed due, the Commissioner is hereby authorized to charge counsel's Deposit Account No. 09-0465 / ROC920030245US1 for any fees, including extension of time fees or excess claim fees, required to make this response timely and acceptable to the Office.

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper. Remarks/Arguments begin on page 8 of this paper.

IN THE CLAIMS:

Please amend the claims as follows:

1. (Currently Amended) A computer-implemented method of cross-selling products based on a system for sale to a customer, comprising:

for each selection by a user of a product from a product information source, receiving an order representing a state of a system based on the user selections; and

in response to receiving each order configuring one or more computer processors of an analyzer with instructions that transform the one or more computer processors into cross-sell logic configured to perform an operation comprising:

determining whether the order qualifies for one or more cross-sell products; and

if so, presenting the one or more cross-sell products to the user, wherein each of the one or more cross-sell products presented to the user is offered at a discount based on the state of the system, and wherein each of the one or more cross-sell products presented to the user is determined to be compatible with the state of the system.

2. (Previously Presented) The method of claim 1, wherein each order is processed as it is received to ensure that the state of the system is valid.

3. (Previously Presented) The method of claim 1, wherein each order is validated as it is received to ensure that the individual products selected by the user from the product information source for the system are compatible and to ensure that the system is properly configured with products necessary for proper operation.

4. (Previously Presented) The method of claim 1, wherein determining whether the order qualifies for one or more cross-sell products comprises applying matching logic to the order to determine whether the order satisfies predefined conditions.

5. (Previously Presented) The method of claim 1, further comprising calculating a price of each order as it is received.

6. (Previously Presented) The method of claim 1, further comprising:

receiving at least one user selection of the one or more cross-sell products;

determining whether the at least one user selection is compatible with the state of the system;

if so, adding the at least one user selection to the system; and

otherwise, if the at least one user selection is not compatible with the state of the system, presenting a message indicating an incompatible user selection.

7. (Original) The method of claim 1, wherein presenting the one or more cross-sell products to the user comprises displaying a notification to the user in a graphical user interface.

8. (Original) The method of claim 7, wherein, for at least one of the one or more cross-sell products, the notification comprises a selectable graphical element for invoking a configuration wizard adapted to facilitate adding the at least one of the one or more cross-sell products to the system.

9. (Currently Amended) A computer-implemented method of cross-selling products based on a system for sale to a customer, comprising:

receiving, from a user, product selections defining the system;

configuring the product selections to represent a configured state of the system based on the product selections;

for each product selection, outputting an order representing the configured state of the system; and

configuring one or more computer processors of an analyzer with instructions that transform the one or more computer processors into cross-sell logic configured to perform an operation comprising:

for each order, determining whether the order qualifies for one or more cross-sell products; and

if so, presenting the one or more cross-sell products to the user, wherein each of the one or more cross-sell products presented to the user is offered at a discount based on the configured state of the system, and wherein each of the one or more cross-sell products presented to the user is determined to be compatible with the configured state of the system.

10. (Previously Presented) The method of claim 9, wherein presenting the one or more cross-sell products to the user comprises displaying the one or more cross-sell products in a system configuration user interface.

11. (Original) The method of claim 9, wherein determining whether the order qualifies for one or more cross-sell products comprises applying matching logic to the order to determine whether the order satisfies predefined conditions.

12. (Original) The method of claim 9, further comprising validating at least one order to ensure that the individual products selected by the user are compatible and to ensure that the system is properly configured with products necessary for proper operation.

13. (Original) The method of claim 12, wherein the validating is performed subsequent to determining whether the order qualifies for one or more cross-sell products.

14. (Original) The method of claim 9, wherein presenting the one or more cross-sell products to the user comprises displaying a notification to the user in a graphical user interface.

15. (Original) The method of claim 14, wherein, for at least one of the one or more cross-sell products, the notification comprises a selectable graphical element for invoking a configuration wizard adapted to facilitate adding the at least one of the one or more cross-sell products to the system.

16-32. (Cancelled)

33. (Previously Presented) A computer-implemented method, comprising:

receiving, in a configuration interface, user selections of one or more component products to be added to a configured system;

determining, based on the user selections of one or more component products, one or more cross-sell products that may be added to the configured system;

determining, based on the user selections of one or more component products, a discounted value for each of the one or more cross-sell products;

providing, in the configuration interface, one or more indications of the one or more cross-sell products available to be added to the configured system, wherein each indication includes the discounted value of the corresponding cross-sell product;

receiving, in the configuration interface, a user selection of at least one cross-sell product to be added to a configured system;

providing, based on the user selections of one or more component products and the user selection of at least one cross-sell product, one or more software wizards to assist the user in configuring the configured system;

receiving, in the one or more software wizards, user instructions defining the configured system, wherein the user instructions indicate a specific arrangement of the one or more component products and the at least one cross-sell product within the configured system;

determining whether the user instructions represent a valid configuration for the configured system;

if so, presenting, in the configuration interface, a message indicating a valid configuration; and

otherwise, if the user instructions do not represent a valid configuration for the configured system receiving, presenting, in the configuration interface, a message indicating an invalid configuration.

34. (Previously Presented) The method of claim 33, wherein determining one or more cross-sell products that may be added to the configured system comprises applying matching logic to determine whether the one or more component products satisfy predefined conditions.

35. (Previously Presented) The method of claim 33, wherein each indication includes a limited quantity of the corresponding cross-sell product available to be added to the configured system.

36. (Previously Presented) The method of claim 35, wherein the limited quantity is based on the user selections of one or more component products.

37. (Currently Amended) A computer-implemented method of cross-selling products to a customer, comprising:

receiving, from a user, product selections to be included in a system;

determining, based on the product selections, a first configured system, wherein the configured system represents a validly operable configuration of the product selections;

retrieving, from a data store, a second configured system, wherein the second configured system was based on at least one order previously received from the same user; and

configuring one or more computer processors of an analyzer with instructions that transform the one or more computer processors into cross-sell logic configured to perform an operation comprising:

determining one or more cross-sell products that are compatible with both the first configured system and the second configured system; and

presenting the one or more cross-sell products to the user, wherein each of the one or more cross-sell products presented to the user is offered at a discount.

38. (Previously Presented) The method of claim 37, wherein the discount is based on the first configured system.

39. (Previously Presented) The method of claim 37, wherein the discount is based on the second configured system.

40. (Previously Presented) The method of claim 37, wherein the discount is based on both the first configured system and the second configured system.

41. (Previously Presented) The method of claim 37, wherein the discount comprises an entire price of each cross-sell product, such that each cross-sell product is offered to the user for free.

42. (Previously Presented) The method of claim 37, wherein each of the one or more cross-sell products presented to the user is offered in a limited quantity.

43. (Previously Presented) The method of claim 42, wherein the limited quantity is based on at least one of the first configured system and the second configured system.

REMARKS

This is intended as a full and complete response to the Examiner's Answer dated December 5, 2008, having a shortened statutory period for response set to expire on February 5, 2009. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-15 and 33-43 are pending in the application and remain pending following entry of this response. Claims 1, 9 and 37 have been amended. Applicant submits that the amendments do not introduce new matter.

Further, Applicants are not conceding in this application that those amended (or canceled) claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the claimed subject matter. Applicants respectfully reserve the right to pursue these (pre-amended or canceled claims) and other claims in one or more continuations and/or divisional patent applications.

Claim Rejections - 35 U.S.C. § 101

The Examiner's Answer states a new ground of rejection under 35 U.S.C. § 101. Claims 1-8 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Applicants have made appropriate amendments. Specifically, claim 8 now recites "configuring one or more computer processors of an analyzer with instructions that transform the one or more computer processors into cross-sell logic configured to perform an operation comprising..." Thus, the claim now recites both a particular machine limitation (i.e., a processor configured as cross-sell logic) and the transformation of the particular processor (a physical article). Further, it has been held that the transformation of a general purpose computer to a special purpose computer renders a claim patentable under 35 U.S.C. § 101. *See*, Alappat 33 F.3d 1526 (1994) (en banc).

Claim Rejections - 35 U.S.C. § 102

Claims 1-15 and 33-36 remain rejected under 35 U.S.C. § 102(b) as being anticipated by *Henson* (US 6,167,383).

Applicant respectfully traverses this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent Claims 1 and 9

In this case, *Henson* does not disclose "each and every element as set forth in the claim". For example, *Henson* does not disclose a computer-implemented method of cross-selling products based on a system for sale to a customer that includes *presenting the one or more cross-sell products to the user, wherein each of the one or more cross-sell products presented to the user is offered at a discount based on the state of the system, and wherein each of the one or more cross-sell products presented to the user is determined to be compatible with the state of the system*, as recited in claim 1. Claim 9 includes a similar limitation. Regarding this limitation, the Examiner argues:

> Henson explicitly discloses offering the user "McAfee VirusScan 3.1 at no additional charge" when the user has selected Microsoft Windows 95 or 98. (Figure 3a). Thus, Henson is offering a cross-sell "at a discount based on the state of the system", but only when it "is determined to be compatible with the state of the system", i.e. only when the user has selected Microsoft Windows 95 or 98.

Final Office Action, page 3. In other words, the Examiner is arguing that a selection box for "McAfee VirusScan 3.1" shown in Figure 3A of *Henson* teaches the recited limitation.

Applicant points out that the selection box cited by the Examiner is not labeled in Figure 3A, and is not in any way discussed or explained in the text of *Henson*. Thus, there is no indication that the McAfee software is being offered "at a discount based on the state of the system," as assumed by the Examiner. Therefore, the Examiner appears to argue that the mere appearance of the phrase "at no additional charge" in Figure 3A of *Henson* inherently teaches the recited limitation.

Applicant respectfully submits that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). *See MPEP* Sec. 2112. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). *See id.*

Applicant respectfully submits that the Examiner's analysis is flawed, since *Henson* does not inherently teach the recited limitation. That is, the limitation that *each of the one or more cross-sell products presented to the user is offered at a discount based on the state of the system* is not necessarily present in Figure 3A of *Henson*. For example, since *Henson* is entirely silent on how the pricing of the software mentioned in Figure 3A is determined, we may just as easily assume that such software is always free regardless of the vendor (i.e., "freeware"), or that such software is included for free with all computer orders, without regard for the state of any included systems. Since such software would not be *offered at a discount based on the state of the system*, Applicant submits that *Henson* does not inherently teach the recited limitation.

Applicant further submits that the cited material does not teach that *each of the one or more cross-sell products presented to the user is determined to be compatible with the state of the system.* The Examiner argues that Figure 3A of *Henson* teaches that the McAfee software is offered "only when the user has selected Microsoft Windows 95 or 98." Thus, the Examiner appears to argue that Figure 3A of *Henson* inherently teaches the recited limitation. However, *Henson* does not disclose that the choices included in the cited selection box of Figure 3A are in any way determined to be compatible with the state of the system (i.e., to a particular OS), as assumed by the Examiner. In fact, as stated above, *Henson* is entirely silent with regards to the selection box shown in Figure 3A. Thus, *Henson* does not teach that determining compatibility with the state of the system is necessarily present in Figure 3A. For example, it may also be assumed that the cited selection box includes multiple software choices, each corresponding to a different OS, with the selection of the proper software (i.e., compatible with the system) being left to the user. Thus, *Henson* does not teach that the *cross-sell products presented to the user is determined to be compatible with the state of the system.*

Independent Claim 33

In the *Final Office Action* dated May 21, 2008, the Examiner argues that claim 33 is taught by *Henson*. Regarding the third clause of claim 33, the Examiner states:

> c. determining a discounted value for each of the cross-sell products (inherent);

Final Office Action, page 5. However, the third clause of claim 33 actually states:

> *determining, based on the user selections of one or more component products, a discounted value for each of the one or more cross-sell products;*

Applicant respectfully submits that omitting the underlined limitation has the effect of mischaracterizing claim 33, and thus trivializes the claim limitation. Therefore, Applicant submits that the Examiner has failed to properly establish the rejection of claim 33.

Further, the Examiner argues that the limitation of *determining, based on the user selections of one or more component products, a discounted value for each of the one or more cross-sell products* is inherent. However, Applicant points out that *Henson* does not in any way teach that a discounted value must be determined for each of the cross-sell products presented in the configuration screen of *Henson*. Since determining a discounted value for each of the cross-sell products is not necessarily present in *Henson*, it is not an inherent feature of *Henson*. Thus, *Henson* does not disclose *determining, based on the user selections of one or more component products, a discounted value for each of the one or more cross-sell products*.

The Examiner also argues that the limitation of *providing, based on the user selections of one or more component products and the user selection of at least one cross-sell product, one or more software wizards to assist the user in configuring the configured system* is taught by the "configuration, pricing, validation, shipment delay indication, and merchandising modules" described in *Henson,* column 6, lines 31-34. Applicant respectfully submits that the claim term "software wizard" refers to a user interface configured to aid a user in performing a defined task. For example, see the software wizard illustrated in Figure 5 of the present application. In contrast, the cited "modules" of *Henson* are not described as software wizards, but rather are described as software components of an "on-line store application." *Henson* fails to teach that such software components are any sort of software wizard. Thus, *Henson* does not disclose *one or more software wizards to assist the user in configuring the configured system*.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 37-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Henson*.

Applicant respectfully traverses this rejection.

The Examiner bears the initial burden of establishing a prima facie case of obviousness. See MPEP § 2141. Establishing a prima facie case of obviousness begins with first resolving the factual inquiries of Graham v. John Deere Co. 383 U.S. 1 (1966). The factual inquiries are as follows:

(A) determining the scope and content of the prior art;

(B) ascertaining the differences between the claimed invention and the prior art;

(C) resolving the level of ordinary skill in the art; and

(D) considering any objective indicia of nonobviousness.

Once the Graham factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

Further, the Federal Circuit points out that in *KSR International Co. vs. Teleflex, Inc.*, 127 S. Ct. 1727 (2007) the Supreme Court "acknowledged the importance of identifying 'a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does' in an obviousness determination." *Takeda Chemical Industries, Ltd. v. Alphaphram Pty, Ltd.*, 492 F.3d 1350, 1356 (Fed. Cir. 2007).

Regarding the rejection of independent claim 37, the Examiner states:

> While Henson does not explicitly disclose receiving a second configured system based on a previous order from the same user, it is disclosed that the user may be an individual, a business (small, medium, or large), or a government employee (Figure 8) and it is also disclosed the system asks if the user is a previous customer (Figure 7). The Examiner

> also notes that compatibility with legacy systems is always a main concern to businesses looking to upgrade or expand their existing systems. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Henson to check the compatibility of the component of the new system to each other, but also the compatibility of the components (and the whole system) with one or more previously ordered systems. One would have been motivated to do such a compatibility check between the systems in order to allow businesses to integrate the new system with their legacy systems. Additionally, if it is determined that the two systems are not compatible (e.g. old Mac system vs new PC system), such a determination may provide the opportunity for the merchant to present an offer to the user for additional software or hardware, such as a MAC to PAC converter

Final Office Action, pages 7-8. The Applicant respectfully submits that the Examiner's reasoning for finding claim 37 to be obvious is merely a conclusory statement (*i.e.*, "it would have been obvious to one having ordinary skill in the art at the time the invention was made for Henson to check the compatibility of the component of the new system to each other, but also the compatibility of the components (and the whole system) with one or more previously ordered systems"), and fails to articulate reasons for a finding of obviousness with sufficient particularity. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); cited with approval in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41 (2007).

Thus, even if we assume, *arguendo*, that one of skill in the art "would have been motivated to do such a compatibility check between the systems in order to allow

businesses to integrate the new system with their legacy systems," the Examiner fails to explain why one would do so in the specific manner recited in the present claims. For example, the Examiner argues that *Henson* discloses that "the system asks if the user is a previous customer (Figure 7)" (*Final Office Action*, page 7). However, *Henson* does not disclose that an earlier system order placed by the customer is then retrieved, or that there is any sort of checking for cross-sell products that are compatible with both a current system order and the earlier system order, as required by the Examiner's argument. In fact, *Henson* does not disclose any sort of storage of earlier system orders at all, or of any need for compatibility across orders. Therefore, the Examiner has not provided a *prima facie* case of obviousness as required by MPEP § 2143.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

Having addressed all issues set out in the Examiner's Answer, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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